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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/717,571	11/21/2003	Koji Shigemura	1670.1020	9396
49455 7590 04/10/2008 STEIN, MCEWEN & BUI, LLP 1400 EYE STREET, NW SUITE 300 WASHINGTON, DC 20005				
EXAMINER				
LIN, JAMES				
ART UNIT		PAPER NUMBER		
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/717,571

Applicant(s)

SHIGEMURA, KOJI

Examiner

Jimmy Lin

Art Unit

1792

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 February 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5, 7-19, 21 and 22 is/are pending in the application.
- 4a) Of the above claim(s) 1-5 and 7-13 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 14-19, 21 and 22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Priority

1. The certified English translation of the Japanese Patent Application No. 2002-339616 priority document was received on 2/14/2008 along with the Reply Brief. According to MPEP 1207.03.V.B., the Reply Brief is treated as a request that prosecution be reopened under 37 CFR 41.39(b)(1) if it is accompanied by any amendment or evidence. The filing of a certified English translation is a submission of evidence. Thus, prosecution of this case has been reopened.

2. It is noted that the priority document supports all the mask limitations of the present claims. However, the priority document does not explicitly teach that the mask can be used to form the second electrode layer, as required by the claims, but does seem to suggest that the deposition of electrodes with a mask was known in the EL art (see paragraph [0010] of English translation). This suggestion seems to indicate that Applicant had possession of deposition of the second electrode with the mask of the present invention.

Additionally, the priority document does not have any sort of teaching about "sealing the electrode layer", as required by the claims. Therefore, the priority document does not fully support the claims and cannot be used to remove WO 2003/019988 to Tsuchiya et al. as prior art.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claim 22 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The rejection has been previously cited in the Examiner's Answer filed 12/19/2007.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 14-17 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Utsugi et al. (U.S. Publication No. 2002/0150674) in view of Ito et al. (U.S. Patent No. 5,652,067) and Martin (U.S. Patent No. 4,676,193).

The rejection has been previously cited in the Examiner's Answer filed 12/19/2007.

7. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Utsugi '674 in view of Ito '067 and Martin '193 as applied to claim 14 above, and further in view of Yamada et al. (U.S. Publication No. 2001/0019807).

The rejection has been previously cited in the Examiner's Answer filed 12/19/2007.

8. Claims 18-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Utsugi '674 in view of Ito '067 and Martin '193 as applied to claim 17 above, and further in view of Kitazume (U.S. Publication No. 2002/0025406).

The rejection has been previously cited in the Examiner's Answer filed 12/19/2007.

9. Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Utsugi '674 in view of Ito '067 and Martin '193 as applied to claim 14 above, and further in view of Fujimori et al. (U.S. Publication No. 2002/0102754).

The rejection has been previously cited in the Examiner's Answer filed 12/19/2007.

10. Claims 14-15, 17-18, and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 2003/019988 to Tsuchiya et al. and Ito '067.

The rejection has been previously cited in the Examiner's Answer filed 12/19/2007.

11. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tsuchiya '988 and Ito '067 as applied to claim 14 above, and further in view of Yamada '807.

The rejection has been previously cited in the Examiner's Answer filed 12/19/2007.

12. Claims 16 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over to Tsuchiya '988 and Ito '067 as applied to claim 14 above, and further in view of Martin '193.

The rejection has been previously cited in the Examiner's Answer filed 12/19/2007.

13. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tsuchiya '988 and Ito '067 as applied to claim 18 above, and further in view of Kitazume '406.

The rejection has been previously cited in the Examiner's Answer filed 12/19/2007.

Response to Arguments

14. Applicant's arguments filed 2/14/2008 have been fully considered but they are not persuasive.

Rejection 1:

Applicant argues on pg. 6-9 that the teaching of dot welding, resistance dot welding, and laser dot welding fully supports "wherein the flat frame and the flat cover mask are the only elements that touch the flat mask". However, Applicant seems to have missed the point of Examiner's argument. Examiner had argued on pg. 12 of the Answer as follows:

The disclosure of a single species (i.e., laser welding) does not reasonably convey to one skilled in the art that Appellant had possession of an entire genus at the time the present application was filed because a genus contains multiple species.

Specifically, the genus of all methods for having the frame and the cover mask being the only elements that touch the mask is not limited to only a single species of laser welding. For example, clamping of the frame and cover mask can achieve a structure wherein only the frame and the cover mask touch the mask. The present specification does not have a disclosure for a method of clamping or an explicit disclosure for the frame and the cover mask being the only elements that touch the mask and, thus, does not fully support the claimed genus because the

disclosure does not include all the species within the genus. If Applicant wishes to claim the specific species as disclosed in the present specification, then the terms as used in the present specification (e.g., dot welding, resistance dot welding, and/or laser dot welding) should be used in the claims.

Rejection 2:

Applicant presents the modification of Fig. 7 of Martin as proposed by Examiner and argues on pg. 13 that the apertures 72 and 96 presumably would no longer be required because the apertures 72 and 96 would no longer be needed to accept the registration members 60 shown in Fig. 1 of Martin to hold the metal foil 40', the modified mask supporting frame 34, and the modified clamping member 88 together. However, Martin seems to teach that the registration members are independent of the mechanism to hold the mask assembly together. The registration pins seem to be used for aligning the mask assembly to the gantry assembly, wherein the gantry assembly includes the deposition substrate and wherein the registration pins of the mask are aligned to the registration members 162,164,166 of the gantry (col. 18, line 54-col. 19, line 34; Figs. 21-23). Therefore, there is no need to remove the apertures 72 and 96 in the rejection directed to claim 14. However, the rejection to claim 22 is directed to the motivation of substituting the registration pins for the alignment marks of Fujimori. Such a substitution would include the removal of the registration pins.

Applicant argues on pg. 14 that the position as taken by the Examiner that "the weight of the clamping member, even without adding the modification of welding, would necessarily provide at least some downward force on the metal foil such that at least some radial tension would be applied to the metal foil" is contrary to the laws of physics. Applicant is correct. A more accurate position would be that the weight of the clamping member would necessarily provide at least some downward force on the metal foil such that at least some radial tension would be *maintained* on the metal foil.

In regards to the arguments on pg. 15-23, Examiner maintains his position as cited in the Examiner's Answer filed 12/19/2007.

Rejection 5:

Applicant argues on pg. 24-26 that the evidence relied on by the Board in *Smith v. Hayashi* was found in a single document which indicated that Pc and selenium are equivalents. Applicant continues to argue that although Martin and Fujimori each disclose a different method of aligning a substrate to a mask for a vapor deposition process, neither of the two references discloses that the two different methods are equivalents. However, two separate disclosures each disclosing a distinct method of performing the *same tasks* would reasonably suggest to one of ordinary skill that the two methods were operable equivalents and that the substitution of one method for the other would predictably achieve the same results.

Rejection 6:

Applicant argues on pg. 26-27 that the publication date of Tsuchiya is March 6, 2003, which is before the U.S. filing date of the present application, but *after* the filing date of November 22, 2002 of Japanese Patent Application No. 2002-339616, the Japanese priority application of the present application. However, the priority application has no disclosure of “sealing the second electrode” as required by claim 14. Thus, the priority application does not fully support the present claims and cannot be used to remove Tsuchiya as prior art to the present claims.

It is noted that the priority document supports all the mask limitations of the present claims. However, the priority document does not explicitly teach that the mask can be used to form the second electrode layer, as required by the claims, but does seem to suggest that the deposition of electrodes with a mask was known in the EL art (see paragraph [0010] of English translation). This suggestion seems to indicate that Applicant had possession of deposition of the second electrode with the mask of the present invention.

Conclusion

15. Because this Office Action does not introduce a new ground of rejection, **THIS ACTION IS MADE FINAL** (see MPEP 1207.03.V.A.). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

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MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jimmy Lin whose telephone number is (571)272-8902. The examiner can normally be reached on Monday thru Friday 8AM - 5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tim Meeks can be reached on 571-272-1423. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jimmy Lin/
Examiner, Art Unit 1792

/Timothy H Meeks/
Supervisory Patent Examiner, Art Unit 1792